

Remarks

Applicants have rewritten claims 45, 46 and 49, and have cancelled claim 44. Accordingly, claims 38 to 43, and 45 to 56 remain pending in this patent application. Applicants now address each and every point noted in the Advisory Action dated August 14, 2003, and present comments in support of the allowance of this application as follows:

I. Rejection of Claims

The rejection of claims 43, 46 to 48, and 50 to 56 under 35 U.S.C. §103, as being allegedly unpatentable over Samonides in view of McNaul, has been maintained in the Advisory action.

A. Independent claim 43

This claim relates to a method for forming a pressure-sensitive adhesive (PSA) construction having the basic structural construction of the following element: (1) a PSA material disposed onto a release surface of a removable substrate; (2) a film-forming material disposed onto a surface of the PSA to form a continuous film thereover; (3) and overlamine film layer disposed onto the continuous film; and (4) a printed indicia interposed between overlamine film layer and the continuous film.

The method recited in claim 43 involves the steps of: (1) applying the PSA material to the release surface of the removable substrate; (2) applying the film-forming material onto a surface of the PSA material, while the pressure-sensitive adhesive material is in a non-final state, to form the continuous film thereover and render the PSA tack free; (3) laminating the overlamine film layer onto the continuous film; and (4) forming the printed indicia onto one of the continuous film or a backside surface of the overlamine film layer adjacent the continuous film. A feature of this claimed method is that the film-forming material is applied to a surface of the PSA while the PSA is in a non-final state. The terms "non-final state" as used in this claim are understood to mean PSA material is

not in a final or fully developed/fully matured state, i.e., it is at a state where it does not yet display the desired final performance properties useful in the completed PSA construction.

The Samonides patent discloses a PSA-backed substrate having basic structural construction of: (1) a release coated carrier; (2) a PSA material deposited on the carrier; (3) a printed indicia applied to a portion of the PSA material; and (4) a protective layer deposited over the printed indicia and a portion of the remaining exposed surface of the PSA material. A critical shortcoming of Samonides is that it fails to disclose or even remotely suggest a PSA construction comprising the further construction element of a continuous film interposed between the PSA and the printed indicia.

This was in fact admitted to by the Examiner in the Office action dated April 5, 2002. Samonides fails to disclose or even remotely suggest the use of such a film-forming layer. The Examiner relies on the teaching in Samonides to deposit the PSA material when it has a low water content, e.g., from 10 to 25%. Samonides discloses that the moisture content for the final label is 5%. Based on the fact that the water content of the PSA material is not the same as the final label product, Samonides that the PSA is "very close to its final form" at the time that it is applied. Applicants do not dispute this point.

However, a key point of distinction lies in the fact that above-noted non-final state of the PSA is at the point of the PSA being applied and is not at the point of any subsequent film-forming material being applied to the PSA. Samonides in fact discloses that after the PSA layer is applied, it is dried to a 5% water content before it is both printed and covered with the protective later. Since Samonides discloses the final label product as having a moisture content of 5%, and the PSA layer is dried to a 5% water content before being printed and coated, Samonides cannot properly be relied upon to support the method step recited in claim 43 of applying a film-forming material onto the PSA when the PSA is in a non-final state.

Accordingly, in addition to Samonides' failure to disclose or suggest a PSA construction and method of preparing the same that comprises a film-forming material disposed onto the PSA material and an overlamine layer disposed onto the film-forming material, Samonides does

not disclose or suggest the further claim feature of applying the film-forming material while the PSA material is in a non-final state.

McNaul discloses a printable laminate construction comprising: (1) a release liner; (2) a PSA material disposed on the release liner; (3) a layer of vinyl film on the PSA material; (3) a printed indicia on the vinyl film surface; and (4) a protective overcoating on the printed indicia. The Examiner apparently relies on McNaul for its teaching of placing a film material over the PSA material, printing on the vinyl film surface, and placing a protective overcoating on the printed indicia. However, McNaul is completely silent about its constructions are made and, more specifically, the state of the PSA material at the time that the vinyl film is applied.

It is important to note that the invention constructions disclosed in McNaul are fundamentally different from that recited in Applicants' claim in that they are made from an assembly of preformed elements, e.g., a preformed carrier tape and application tape, rather than made from a process involving the forming the constriction from raw materials. For this reason it is not surprising that McNaul is completely silent with respect to the specific concepts and methods of fabrication that involve the step of forming a protective film layer over the PSA layer at any point when the PSA layer is other than in a finished and completely developed state, i.e., is in the form of a completed assembly element.

Thus, taking the combination of Samonides and McNaul, one having ordinary skill in the art would not be motivated by the combined teaching of Samonides or McNaul to develop a method of making a PSA construction comprising a method step that is neither disclosed nor suggested in each; namely, the step of applying the film-forming material when the PSA layer is in a non-final state. Applicants submit that both Samonides and McNaul each fail to disclose or suggest this invention feature. Therefore, Applicants submit that its invention as recited in independent claim 43 is not obvious over the combined teachings of Samonides and McNaul, and for that reason respectfully request that the rejection of independent claim 43 under 35 U.S.C. §103 be reconsidered and withdrawn.

B. Independent Claim 46

This claim recites a method for forming an overlaminated PSA construction that involves, inter alia, the steps of: (1) applying a PSA material to a release surface; and (2) applying a film forming material onto a surface of the PSA material. A key feature of this claim is that all of the recited method steps are carried out during a continuous process.

As discussed above, Samonides fails to disclose or even remotely suggest a PSA construction or method for making the same that involves the step of applying a film-forming material to a surface of a PSA material, yet alone doing this as a part of a continuous process. Also, as noted above, McNaul fails to disclose or suggest any method for making that involves the use of raw materials in the applying steps. Again, McNaul discloses the concept of producing a construction from an assembly of preformed elements. Further, McNaul indicates that its final product may be assembled at a location different from and at a time after the different preformed elements are made.

Since both Samonides and McNaul fail to disclose or remotely suggest the claim features noted above, Applicants' submit that the combination of these two patents cannot properly render obvious that which is missing in each. Therefore, one having ordinary skill in that art would not find Applicants' invention as recited in claim 46 to be obvious in view of the combination of Samonides and McNaul, as neither provides any motivation to produce a PSA construction according to the manner recited in the claim.

Applicants, therefore, respectfully request that the rejection of independent claim 46, and claims 47, 48 and 50 to 56 depending therefrom, under 35 U.S.C. §103 be reconsidered and withdrawn.

II. Allowed Claims

Applicants acknowledge with appreciation the noted allowance of claims 38 to 42, and hereby accept the same

III. Allowable Claims

Applicants acknowledge with appreciation the Examiner's noted allowability of claims 44, 45 and 49 if rewritten into independent form. Applicants, have rewritten claims 45 and 49 into independent, submit that these claims are in allowable form, and hereby accept allowance of the same.

IV. Request for Telephone Interview with Examiner

Should, after entering this amendment and considering all of the points presented, the Examiner decide to maintain his rejections of the claims based on the two prior art patents discussed above, Applicants respectfully request that the Examiner please contact its attorney or record for the purpose of conducting a telephone interview regarding any such maintained rejection. If possible, Applicants would like to invite the Examiner's supervisor to also participate in any such telephone interview.

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Appl. No. 09/925,836
Amdt. dated October 24, 2003
RCE and Amendment further to Notice of Appeal filed 07/25/2003

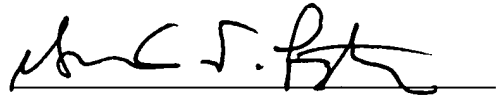
V. Conclusion

Applicants accept the allowance of claims 38 to 42, and claims 45 and 49, and respectfully request that the rejection of the claims under 35 U.S.C. §103 be reconsidered and withdrawn, and that these be passed to allowance.

The Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 10-0440, or credit any overpayment to the same.

Respectfully submitted,

Date: 10/24/03


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